

REMARKS

Claims 2-7 are pending in the application. In the Office action dated April 20, 2007, claims 2 and 4 were objected to; claims 2, 4, 6, and 7 were rejected under 35 U.S.C. § 102; and claims 2, 3, and 5 were rejected under 35 U.S.C. § 103. In this paper, claims 2 and 4 are amended. In view of the amendments above, and the remarks below, Applicant respectfully requests reconsideration of the rejected claims under 37 C.F.R. § 1.111.

Objections to the Claims

Claims 2-7 are objected to due to informalities in the claims. Without acknowledging the propriety of the Examiner's objections, Applicant has amended the claims in order to more particularly define the invention.

Claim 2 is objected to because the element "the state" has insufficient antecedent basis. In response, claim 2 has been amended to provide proper antecedent basis for "the state".

Claim 4 is objected to because the recitation "or at each vertex" is considered indefinite. In response, claim 4 has been amended to recite that the fold line is disposed at an acute angle with respect to the back (as shown in Fig. 7), or the fold is disposed at each limb vertex (as shown in Fig. 5).

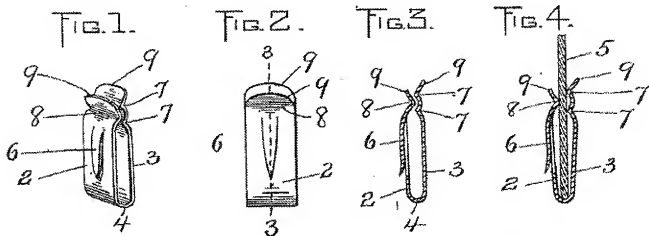
As amended, Applicant suggests the claims are definite and precise, and therefore respectfully request the withdrawal of the objection to claims 2-7.

Rejections under 35 USC § 102

Claims 2, 4, 6, and 7 are rejected under 35 U.S.C. § 102(b) as being anticipated

by Senna (U.S. Patent no. 658,965). Applicant respectfully suggests that the Examiner has misinterpreted the disclosure of Senna.

In particular, the Examiner asserts in the Office action that "the fold itself being disposed at an acute angle with respect to the back (Figs. 3 and 4)". Applicant respectfully disagrees. As shown below, in Figs. 1-4 of Senna, folds 7 and 8 run parallel to the back 4 of the necktie holder of Senna:



This is contrasted with the embodiments presented in the present disclosure having a fold disposed at an acute angle with respect to the back. This is perhaps most clearly shown in Fig. 7, where angle 4a made by the fold 4 with the back 2 is clearly acute:

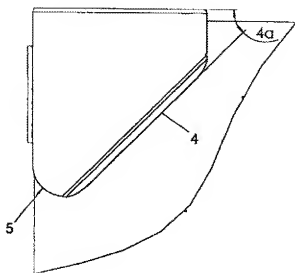


Fig. 7

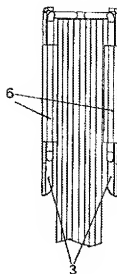


Fig. 8

Furthermore, this difference in the orientation of the fold between the necktie clip of Senna and the claimed clip invention is not arbitrary, or simply a matter of design. The angle 4a between back 2 of the clip and the direction of the fold 3 creates heretofore unreachable combination of high clamping power and an ease of use.

Similarly, the clip embodiment shown in Fig. 5 of the present disclosure, which has a fold parallel to the back and disposed at a vertex 8 of the limbs, also exhibits an unexpected combination of clamp strength and ease of use. However, the clip of Fig. 5 is distinct from the necktie clip of Senna. Although the limbs of the Senna clip are rounded, and therefore have a vertex, the fold is not disposed at the vertex. Clearly as shown in Figs. 3 and 4, the fold at the vertex of the limbs of the Senna clip is an outward fold, not an inward fold as recited in claim 4.

With respect to the rejection of claim 2, Applicant suggests that none of the necktie clips of Senna incorporate a spring, as recited in claim 2.

With respect to the rejection of claim 7, Applicant suggests that the clip of Fig. 4 of Senna fails to include "projections incorporated into the limbs". The Examiner has not identified what parts of the clip of Senna he considers to correspond to such projections. While folds 7 and 8 may be directed inwardly, Applicant disagrees that a linear inward fold can constitute a projection.

As discussed above, Applicant suggests that the Senna reference fails to disclose each and every element of the rejected claims, as set out in the claims. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claim 4, and of claims 2, 6, and 7 depending from claim 4, under 35 U.S.C. § 102.

Rejections under 35 U.S.C. § 103

Claims 2, 3, and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Senna in view of Burleigh et al. (U.S. Patent no. 2,310,835).

The Examiner suggests the Senna clip includes all the features recited in the rejected claims except for disclosing that both limbs are arranged on top of each other and parallel to each other and tensioned by means of a spring.

The Examiner then asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate a clip having both limbs arranged on top of each other and parallel to each other in a state with a clamped stack of sheets by means of a spring as taught by Burleigh, in the clip disclosed by Senna, as doing so would allow the limbs to be parallel to each other at all times while providing a firm grip on the sheets.

The Applicant suggests that stating the "allowing the limbs to be parallel to each other" is an insufficient reason to modify the clip of Senna to make the limbs parallel to

each other, in the absence of any additional motivation or suggestion as to the desirability of making such a modification. As set out at MPEP § 2143.01, the prior art must provide a suggestion of the desirability of the claimed invention. For at least this reason, Applicant suggests that the Examiner has failed to establish the *prima facie* obviousness of the rejected claims.

Furthermore, the Applicant respectfully suggests that the combination of Burleigh and Senna is inappropriate under 35 U.S.C. § 103, because an artisan of ordinary skill concerned with a clip for clamping sheets of paper would not look to the field of necktie holders in attempting to solve a problem. Further, it would be inappropriate to modify the clip of Senna to increase its clamping power, as a gentleman would not risk damaging his collar or necktie by using a clamp that engaged his clothing too severely.

However, even in combination neither Senna nor Burleigh disclose a clip having an inward fold disposed at an acute angle with respect to the back, or disposed at each limb vertex. This deficiency of Senna is discussed above, and with respect to Burleigh, it is obvious that the gripper portions 4 of the Burleigh mail holder are "flared outwardly to form, with the upper edge of the oppositely disposed gripper, open lips 5 between which letters, billheads and the like may be inserted therebetween without the necessity of spreading apart the grippers themselves" (col. 2, lines 7-12).

It is therefore apparent that modification of the Burleigh clip to create an inward fold to clamp the paper sheets held within the clip, as proposed by the Examiner, would change the principle of operation of the Burleigh clip, which is to gently hold letters or other stackable papers in a manner "permitting the withdrawal of one or more letters from the stack without disturbing the position of the remainder" (col. 1, lines 9-17).

Applicant suggests that modifying the clip of Burleigh so as to create a clip having a "strong grip on the sheets", as suggested by the Examiner, would destroy the stated utility of the Burleigh mail holder, and where the proposed modification changes the principle of operation of a reference, or renders the prior art unsatisfactory for its intended purposes, there can be no motivation to modify the reference as suggested by the Examiner (MPEP § 21043.01).

In view of the remarks above, Applicant respectfully suggests that the Examiner has failed to establish the *prima facie* obviousness of the rejected claims, and therefore requests the withdrawal of the rejection of claims 2, 3, and 5 under 35 U.S.C. § 102.

It is believed that the subject patent application has been placed in condition for allowance, and such action is respectfully requested. If the Examiner has any questions or concerns, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned agent of record.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 11-1540.

CERTIFICATE OF E-FILING

I hereby certify that this correspondence is being transmitted electronically via the United States Patent and Trademark Office's EFS-Web System on October 22, 2007.

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Respectfully submitted,

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